

**REMARKS**

Claims 1-14 are all the claims pending in the application.

**I. Rejection under 35 U.S.C. § 112**

Claims 11-14 stand rejected under 35 U.S.C. § 112, first paragraph, because the specification allegedly does not reasonably provide enablement for speech-recognition related parts and non-speech related parts are simultaneously contained within the control signals and response signals. Applicants respectfully disagree with the Examiner's position.

The enablement requirement refers to the requirement of 35 U.S.C. 112, first paragraph, that the specification describe how to make and how to use the invention (MPEP 2164). Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the

invention from the disclosures in the patent coupled with information known in the art without undue experimentation.").

In order to make a rejection, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (Examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure) (MPEP 2164.04).

Turning to a first exemplary embodiment of the present specification, the sixth full paragraph on page 2 of the specification is at least one instance which supports “control signals comprising speech-recognition related parts and/or non-speech-recognition related parts.” Also, the seventh full paragraph on page 2 of the specification refers to “detecting speech-recognition related parts and/or non-speech-recognition related parts in said control signals originating from said terminal, [such that] a user of said terminal has the option to either use keys or mouse etc. or to use speech for controlling the system.” Therefore, the present specification clearly discloses that a control signal comprises both speech-recognition related parts and non-speech-recognition related parts, which originate from the same terminal (i.e., simultaneously).

In addition, according to a third exemplary embodiment of the present invention, the second full paragraph on page 3 of the specification is at least one instance which supports “response signals comprise speech-recognition related parts and/or non-speech recognition related parts.” Also, the third full paragraph on page 3 of the specification refers to “detecting speech-recognition related parts and/or non-speech-recognition related parts in said response signals originating from said memory....” Furthermore, page 7 of the specification describes

alternatives to the first exemplary embodiment, in which “both said speech-recognition related part and said non-speech-recognition related part [of the response signal] are sent from unit 35 via connection 56 and coupler 33 and connection 50 and base station 5 to terminal 1, with said speech-recognition related part of course still being sent to server 2.” That is, the response signal comprises both speech-recognition related and said non-speech-recognition related parts, which are both sent together (i.e., simultaneously) from unit 35 to terminal 1. Therefore, the present specification clearly discloses that a response signal comprises both speech-recognition related parts and non-speech-recognition related parts, which originate from the same terminal (i.e., simultaneously).

Furthermore, the third full paragraph on page 10 of the specification recites:

All embodiments are just embodiments and do not exclude other embodiments not shown and/or described. All alternatives are just alternatives and do not exclude other alternatives not shown and/or described. Any (part of an) embodiment and/or any (part of an) alternative can be combined with any other (part of an) embodiment and/or any other (part of an) alternative.

A person skilled in the art can reasonably infer that since different embodiments and alternative embodiments can be combined and since both control signals and response signals each contain both speech recognition and non-speech recognition related parts, that both the speech recognition related part and the non-speech related part are simultaneously contained within each of said control signals and are simultaneously contained within each of said response signals. Therefore, support exists in the specification wherein both the speech recognition related part and the non-speech related part are simultaneously contained within each of said control signals and are simultaneously contained within each of said response signals.

The Examiner has not met the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.

Thus, Applicants submit that the specification complies with the enablement requirement with regard to all features of the claims and respectfully request the Examiner to withdraw this rejection for at least the above reasons.

## **II. Rejection under 35 U.S.C. § 102**

Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Urs et al. (US Patent No. 6,292,781). In particular, the Examiner asserts:

Urs reads on the detection and appropriate processing of speech and non-speech data in control and/or response signals, since the system of Urs specifically provides for processing both voice and data information in the communication signals transmitted to and from the user and the various components of the communication system with the voice and data path being utilized simultaneously by the communication unit when the wireless resource communication is shared, wherein the system provides for both voice and data signals to be generated by the user as an input signal and provides for both voice and data to be transmitted back to the user in response to the user input. This allows for each control signal by the user to be able to provide both speech input via the speech recognizer and non-speech input via a keyboard/text input as well as each response signal to be able to provide a speech output via the speech synthesizer and a nonspeech output via the display.

However, claim 1 recites that “each of said control signals and said response signals comprising both speech recognition and non-speech recognition related parts.” That is, a control signal comprises both a speech recognition part and a non-speech recognition related part, and a response signal also comprises both a speech recognition part and a non-speech recognition related part.

Urs, on the other hand, discloses that either a request for a voice connection or a request for a data connection is provided by the communication service (col. 5, lines 8-16 and col. 7, lines 23-32). In addition, Ur discloses that only one of the connections (e.g., voice or data) may be utilized at a time, and switching between the voice connection and the data connection requires an indication to be transmitted to the communication infrastructure (col. 7, lines 35-39). Therefore, Urs discloses that that the control signals and the response signals which include a speech recognition related part is separate and distinct from the control signals and the response signals which include a non-speech recognition related part.

The Examiner appears to rely on column 12, lines 3-14 of Urs for disclosing the control signals and response signals of claim 1. Column 12, lines 3-14, merely describes that the voice path and data path can be simultaneously utilized by the communication unit, since the wireless communication resource is shared. However, this does not indicate that a control signal comprises both a speech recognition part and a non-speech recognition related part, or that a response signal comprises both a speech recognition part and a non-speech recognition related part. Column 12, lines 3-14, merely discloses an alternative embodiment to that previously described above in which a voice path and a data path can be simultaneously utilized. According to the previous embodiment, the control signals and the response signals which include a speech recognition related part is separate and distinct from the control signals and the response signals which include a non-speech recognition related part. Therefore, Urs at best discloses that two separate control signals, each having either a speech recognition part or a non-speech recognition related part, can be simultaneously utilized by the communication unit. Thus, a user may request separately a voice or a data function while the other function is being utilized. Urs also discloses

as a result of this sharing, there is a reduction in the capacity of the wireless communication resource and may result in degraded voice quality for voice communication carried via the voice path (col. 12, lines 3-14). In other words, the additional signals reduce the capacity on the wireless resource.

The Examiner appears to be making his conclusions based on the disclosure of the present Application instead of relying on what is taught or suggested in the cited art. That is, we note that impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. Furthermore, two embodiments in a single reference may not be combined absent specific teaching. *In re Kramer*, 18 USPQ2d 1415, 1416 (Fed. Cir. 1991); *Ex parte Beuther*, 71 USPQ2d 1313, 1316 (BPAI 2003). There is no teaching in the reference to support the Examiner's position.

In view of the above, Urs does not disclose that both a speech recognition part and a non-speech recognition related part are simultaneously contained in a single signal. Therefore, Urs fails to disclose that each of said control signals and said response signals comprising both speech recognition and non-speech recognition related parts, as recited in claim 1.

Claims 5, 8 and 10 include analogous, though not necessarily coextensive features, and therefore, claims 5, 8 and 10 are also patentable for the reasons discussed for claim 1.

Applicant submits that the remaining claims are patentable at least by virtue of their dependencies.

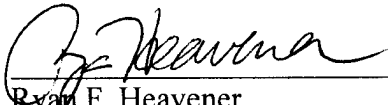
Applicants note that claims 11-14 have not be rejected by any cited prior art. Therefore, claims 11-14 should be patentable at least by virtue of their respective dependencies.

### III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
Ryan F. Heavener  
Registration No. 61,512

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: March 26, 2008